



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,596	01/30/2001	Mark R. Bennett	END9-2000-0188US1	2376

23550 7590 11/27/2006

HOFFMAN WARNICK & D'ALESSANDRO, LLC
75 STATE STREET
14TH FLOOR
ALBANY, NY 12207

EXAMINER

ALLEN, WILLIAM J

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/772,596	Applicant(s) BENNETT ET AL.	
	Examiner William J. Allen	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-11, 14, 16-23 and 25-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-11, 14, 16-23, and 25-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3625

DETAILED ACTION

Prosecution History Summary

Claims 1-2, 4-11, 14, 16-23, and 25-31 are pending and rejected as set forth below.

Response to Arguments

Applicant's arguments with respect to claims 1-2, 4-11, 14, 16-23, and 25-31 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1, 2, and 4-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute “descriptive material.” Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of “descriptive material” are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the

Art Unit: 3625

function of the descriptive material to be realized.

Applicant's "communication system 24, which comprises the various systems of claim 1, is directed to a "software product" which is stored in memory 12 (see at least: Applicants Specification, Paragraph 32). The recited systems of claim 1 are thereby directed to software per se and are thereby non-statutory (note: simply applying the "system" label does not make a claim statutory). Furthermore, since claims 2 and 4-10 depend from claim 1, claims 2 and 4-10 are thereby non statutory and rejected as set forth with regards to claim 1.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-2, 4-11, 14, 16-23, and 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivera (US 20020107699) in view of Walker (5794207).**

Regarding claims 1-2, 4-11, 14, 16-23, and 25-31, and addressing claims 11, 14, 16, and 17 specifically, Rivera teaches:

receiving on an information exchange system a transaction element from a first trading partner intended for a second trading partner specified by the first trading partner (see at least: abstract, 0007) – Note the buyer (first partner) places an order with a supplier (i.e. specifies an order to the second trading partner);

translating the transaction element from a proprietary schema of the first trading partner in to a universal schema and from the universal schema into a proprietary schema of the second trading partner (see at least: abstract, 0007, 0010, Fig. 9)

wherein translation of the transaction element includes translating a data format and an application format of the transaction element (see at least: 0008-0009, 0011);

Art Unit: 3625

routing the transaction element from the first trading partner in a first communication protocol to the second trading partner in a second different communication protocol (see at least: 0035-0036, 0044, 0047, 0051, 0054);

sending a response transaction element from the second trading partner to the information exchange system and routing the response transaction element to the first automotive trading partner (see at least: Fig. 9, 0010, 0047);

mapping the transaction element and the response transaction element with a mapping system, wherein the mapping comprises identifying the first trading partner, the second trading partner, and an application to which the transaction element corresponds (see at least: 0007-0008, 0039);

managing the transaction element and the response transaction element with a mapping system, wherein the managing step comprises tracking a status of the transaction element and the response transaction element (see at least: 0010-0011, 0039, 0057);

securing the information exchange system with a security system (see at least: 0032, 0044, 0047, 0051).

Though Rivera teaches all of the above as noted, Rivera does not teach where the information exchange system is an *automotive exchange system* and the trading partners are *automotive*.

Walker teaches a system using EDI for creation and exchange of conditional purchase offers (see at least: abstract, col. 5 lines 25-45). Walker further teaches where a buyer and supplier are a purchaser seeking to procure a car, find car repair services, or provide car rental services (see at

Art Unit: 3625

least: col. 10 lines 44-46, col. 2 lines 28-33 and 37-38, col. 16 line 6, and Fig. 5 #'s 515 and 535).

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Rivera to have included an automotive exchange system and automotive trading partners as taught by Walker in order to facilitate buyer driven commerce by allowing buyers to submit customized conditional purchase orders for desired products and services such as automotive services (see at least: Walker, abstract).

The Examiner notes that Claims 1-2, 4-10, 18-23, and 25-31 closely parallel claims 11, 14, 16, and 17. Claims 1-2, 4-10, 18-23, and 25-31 are thereby rejected for at least the reasons above.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

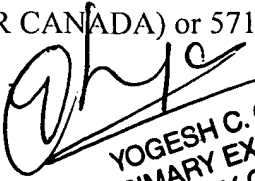
- US 5557780 discloses an electronic data interchange system for managing non-standard data
- US 20020013731 discloses a pre-processor for inbound sales order requests

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen
Patent Examiner
November 16, 2006


YOGESH C. GARG
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600